

REMARKS:**Election/Restriction Requirement**

In response to the restriction/election requirement made in the Office Action, Applicant hereby elects to prosecute Claims 1-34 (Group I) without traverse.

Objection to the Specification

The term "Working Examples" does not mean "Experiments" but mean "Sample Tapes" used in experiments. For instance, Working Example 1 in Fig. 1 is a sample tape which has the physical properties identified by "Properties of evaluated samples" shown in Fig. 1. The Examiner objected to Working Example 4 appearing twice in Figs. 1 and 2. That is not an error and presents no contradiction. That means that Sample 4 was tested twice under different test conditions. More specifically, Working Example 4 as shown in Fig. 1 and Working Example 4 as shown in Fig. 2 have the same properties (Shape of particles, Material for particles, Particle hardness, Average grain size, Average particle length, Particle content and Coating thickness) because they are indeed the same sample. However, their "Evaluation results" and the "Parameters" are different because different tests (Tests A and B) were conducted upon them. Fig. 1 shows evaluation results for Test A. Fig. 2 shows evaluation results for Test B.

Since the terminology "Examples" may have confused the Examiner, Applicant has changed, in the above amendment, the terminology to "Samples" throughout the specification.

Applicant appreciates the Examiner's suggestion that the Working Examples be presented in the figures before presenting the Comparative Examples. In Fig. 1, which shows the evaluation results for Test A, the Examples and the Comparative Examples are presented as suggested by the Examiner. In Fig. 2, which shows the evaluation results for Test B, no Comparative Examples were tested. Since the evaluation results for the different tests are presented in Fig. 1 and 2, Applicant would keep presentation of the Examples as currently they are in Figs. 1 and 2.

In connection with the amendment to the specification, the same amendment has also been to the drawings to have the consistency of the descriptions in the

specification and the drawings.

Claim Objection under 35 U.S.C. 112, Second Paragraph

Applicant has amended the claims in the above amendment. It is believed that the amendment to the claims have obviated the claim objections.

Claim Objection under 35 U.S.C. 112, First Paragraph

The Examiner indicated in the Office Action that the weight percentage range of the particles be numerically defined in the independent claims because it appears critical to the practice of the invention. Paragraph 24 of the specification reads as follows:

[0024] In addition, with the constitution described above, the present invention sets the needle-shaped particle content ratio of the adhesive film composition to 1.0-3.0 wt.%. The reason for this is that, if the needle-shaped particle content is lower than 1.0 wt.%, then cases in which the ease of cutting cannot be maintained stable arise, but if higher than 3.0 wt.%, then cases in which the adhesive strength decreases may arise.

Applicant does not believe that the above paragraph states that the invention will become inoperable if the percentage is out of the range. It states that if it is lower than the range, the ease of cutting cannot be maintained stable, meaning that cutting may not be always easy. The paragraph also states that if it is higher than the range, the adhesive strength decreases. It does not state that if it is higher than the range, the adhesive will not be able to function as an adhesive. Therefore, Applicant declines the Examiner's invitation to numerically define the weight percentage range of the particles in the independent claims.

Claim Rejection under 35 U.S.C. 103(a)

In the Office Action, claims 1-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-240812 ("the '812 reference") in view of JP S61-066772 ("the '772 reference"). Claims 18-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-240812 in view of JP S61-066772 in further view of Fischer.

The '812 reference discloses an adhesive tape with an adhesive layer which contains fillers. The fillers contained in the adhesive layer function to lower the bonding strength of the adhesive layer and make the layer easier to break. However, the bonding strength of the adhesive layer must be strong enough to effect the utility of the tape. The '812 reference states that a ratio between the thickness of the adhesive layer and the diameter of the fillers should be between 0.6 and 8.0. The larger the diameter of the fillers becomes, the lower the bonding strength of the adhesive layer becomes, but the easier it should be to break. The above ratio is determined to maintain the appropriate degree of bonding strength of the adhesive layer with the fillers, while making the adhesive layer easier to break.

There is nothing in the '812 reference that discloses or teaches the elongate particles of the present invention. The '812 reference discusses the diameter of the particle. Therefore, it is believed that the particle of the '812 reference should be spherical or close to being spherical. Also, the fillers of the '812 reference function to lower the bonding strength and make the layer easy to break. In the present invention, however, the elongate particles in the adhesive layer do not compromise the bonding strength of the layer, while functioning to cut the adhesive layer.

The '772 reference discloses adding ceramic fibers in an adhesive to increase the bonding strength of the adhesive. There is nothing in the '772 reference that discloses or teaches the elongate particles of the present invention, which function to cut the adhesive layer.

More importantly, there is no motivation to combine the '812 reference and the '772 reference. In the '812 reference, the fillers are added to decrease the bonding strength, while in the '772 reference, the ceramic fibers are added to increase the bonding strength. These two references have totally opposites and contradicting teachings. It is believed that no one would be motivated to combine the '812 reference and the '772 reference.

Respectfully submitted,

May 12, 2006

Date



Tadashi Horie (Reg. No. 40,437)

BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, IL 60610
(312) 321-4200